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EXAMINER

HOFFMAN, BRANDON S

ART UNIT

PAPER NUMBER

2171

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/597,160

Applicant(s)

SUGAHARA, TAKAYUKI

Examiner

Brandon Hoffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 2 and 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. JP 11-179596/1999, filed on June 25, 1999.

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

### *Specification*

2. The abstract of the disclosure is objected to because line 12 says, "extracted by a extractor". The correct sentence should say, "extracted by an extractor". Correction is required. See MPEP § 608.01(b).
3. The disclosure is objected to because of the following informalities:
  - On page 1, line 18, the sentence "There provided various methods of concealing" is not clear as to what is being said. Consider the word "there" in this sentence; changing this word may make the sentence read better.
  - On page 2, line 10, "which is resemble to" would be clearer if stated, "which is similar to", or "which resembles".
  - On page 3, line 15, "form" should be "from".

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- On page 3, lines 19 and 20 and line 22, "There is existed" should be "There exists".
- The correction above, "There exists", is found in other places throughout the specification. Applicant should fix all of these occurrences.
- On page 7, lines 8-10, "there provided a recording method of an electronic watermark comprising" would be clearer if written as "a recoding method of an electronic watermark is provided, comprising".
- On page 7, line 18, "object" should be "objects".
- On page 10, line 10, "inserter 1" should be "inserter 4".
- On page 17, lines 9, "while" should be "with".

Appropriate correction is required.

### ***Claim Objections***

4. Claims 2 and 3 are objected to because of the following informalities:

- Regarding claim 2, "deciding means for judging whether or not there is existed the second electronic watermark" should be "deciding means for judging whether or not the electronic watermark exists".
- Regarding claim 3, this claim is dependent upon claim 2 and therefore inherits its deficiencies.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a)<sup>1</sup> as being unpatentable over Nakano (U.S. Patent No. 6,510,233) in view of Wakasu (U.S. Patent No. 6,453,053).

Regarding claims 1 and 4, Nakano teaches a recording apparatus/method of an electronic watermark comprising (figure 1):

- Detecting means for detecting a first electronic watermark signal from an original contents data inputted (figure 1, ref num 180 and col. 6, lines 63-66);
- Memory means for storing the first electronic watermark signal detected by said detecting means temporarily (figure 1, ref num 170 and col. 6, lines 66 and 67);  
and
- Inserting means for recording a second electronic watermark signal (figure 1, ref num 130 and col. 7, lines 17 and 18) of which content is equivalent to that of the first electronic watermark signal detected by said detecting means (figure 1, ref

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<sup>1</sup> Claims 1-3 are considered to invoke 35 U.S.C. 112(6) because the claimed construction meets the 3-prong test outlined in MPEP § 2181.

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num 180 and col. 4, lines 63-66) in the contents data extracted by said extracting means.

Nakano does not teach extracting means for extracting a part of contents data from the original contents data.

Wakasu teaches extracting means for extracting a part of contents data from the original contents data (figure 1, ref num 103 and col. 8, lines 31-36).

It would have been obvious to one skilled in the art, at the time the invention was made, to have modified Nakano to include an extracting means for extracting a part of contents data from the original contents data. It would have been obvious to one skilled in the art, at the time the invention was made, to have modified Nakano by the teachings of Wakasu to include an extracting means to extract blocks from the input data which makes an object of insertion of electronic watermark data (see col. 8, lines 32-35 of Wakasu).

Regarding claim 2, Nakano as modified above by Wakasu, teaches the recording apparatus of claim 1 (see figure 1 of Nakano), further comprising:

- Deciding means for judging whether or not there exists the second electronic watermark (see figure 1, ref num 180 and col. 7, lines 18-21 and 26-31 of Nakano); and

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- Switching means for switching an output in accordance with a result of judgment by said deciding means (see figure 1, ref num 190 and col. 7, lines 23-31 of Nakano).

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano as modified by Wakasu, and further in view of Yoshida et al. (U.S. Patent No. 6,449,378).

Nakano as modified above by Wakasu, teaches all of the claimed subject matter set forth in claims 1 and 2 above, except the recording apparatus of claim 2, further comprising:

- MPEG encoder means,
- MPEG decoder means, and
- Another inserting means for receiving an intra-coded picture location signal from the MPEG encoder means, wherein said inserting means records the first electronic watermark signal in a case that the original contents data is an intra-picture.

Yoshida et al. teaches:

- MPEG encoder means (see figure 1, reference numbers 113 & 114 and col. 8, lines 41-45 of Wakasu),
- MPEG decoder means (see figure 2, reference numbers 201 & 202 and col. 9, lines 6-9 of Wakasu), and

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- Another inserting means for receiving an intra-coded picture location signal from the MPEG encoder means, wherein said inserting means records the first electronic watermark signal in a case that the original contents data is an intra-picture (see Yoshida, column 1, lines 55-62).

One with ordinary skill in the art, at the time the invention was made, would have provided an MPEG encodings means, and MPEG decoding means, and another inserting means for receiving an intra-coded picture location signal from the MPEG encoding means, wherein said inserting means records the first electronic watermark signal in a case that the original contents data is an intra-picture in Nakano and Wakasu as suggested by Yoshida et al. One with ordinary skill in the art would include an MPEG encoding and decoding means to allow compression of video to provide a faster way to transmit video.

One with ordinary skill in the art would insert a watermark every time the MPEG encoder detected an intra-coded signal because inserting an electronic watermark in a case that the original contents data is an intra-coded picture would allow the process of encoding and decoding to be much faster. To support my statement, I am referring to Yoshida, who teaches, in column 1, lines 55-62, the intra-coded pictures are assigned at the beginning of each 15-frame GOP (group of pictures) (Yoshida, column 8, lines 55-57). This motivation/suggestion would explain why someone with ordinary skill in the art, at the time the invention was made, would want to insert a watermark every time the intra-coded picture signal was detected by the MPEG encoder.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Hoffman whose telephone number is 703-305-4662. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

*Brandon Hoffman*

BH  
August 20, 2003

*S. Metjahic*  
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